

REMARKS

Claims 1, 11 and 20-38 have been amended. Claims 1-57 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Provisional Double Patenting Rejections:

The Examiner provisionally rejected claims 8, 17, 27, 36, 46, and 55 for statutory double patenting under 35 U.S.C. § 101 in regard to co-pending application no. 10/670,550. Applicant notes that this rejection is obviated by amendments made in application no. 10/670,550. Thus, removal of this rejection is respectfully requested.

The Examiner provisionally rejected claims 9, 18, 28, 37 for statutory double patenting under 35 U.S.C. § 101 in regard to co-pending application no. 10/670,549. Applicant notes that this rejection is obviated by amendments made in application no. 10/670,549. Thus, removal of this rejection is respectfully requested.

The Examiner provisionally rejected claims 1, 11, 20, 30, 39, and 49 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 14, 27, 28, 41, and 42 of co-pending Application No. 10/670,550. This rejection should be reconsidered in view of the amendments made in co-pending Application No. 10/670,550.

The Examiner provisionally rejected claims 1, 11, 20, 30, 39, 47, 49, and 56 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 19, 20, 29, 29, 30 and 30, of co-pending Application No. 10/670,549. This rejection should be reconsidered in view of the amendments made in co-pending Application No. 10/670,549

Section 101 Rejection:

The Examiner rejected claims 1, 8, 9, 17-20, 27, 28, 36-39, 46, 47 and 55-57 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection for at least the following reasons.

The Examiner asserts that because results are not displayed to an output device, there is no tangible output result. However, there is no requirement that a result be displayed to an output device to satisfy the requirements of 35 U.S.C. § 101. Claim 1 recites a computer implemented method comprising... *receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.* Note that claim 1 has been amended to be a computer implemented method. Clearly, claim 1 does not cover a law of nature, natural phenomena or abstract idea. There is nothing abstract about claim 1. These are all concrete, useful and tangible elements that have a clear practical application in the arts. The instant messaging operation, presence state, the ability to determine presence state and selectively processing the instant messaging operation dependent upon the presence state, are elements that limit the scope of the act of processing an instant messaging operation directed at a user. In addition, the tangible result is -- the selectively processed instant messaging operation based upon the presence state for a given user. In a computer-implemented method, a selectively processed instant messaging operation clearly produces a useful, concrete and tangible result.

Again, the language of the claims requires the acts of receiving an instant messaging operation directed at a given user, determining a presence state of an instant messenger in response to receiving the instant messaging operation and selectively processing the instant messaging operation dependent upon the presence state in response to determining. The claim does not recite these acts in the abstract. According to the

Guidelines cited by the Examiner, the “useful, concrete and tangible result” analysis **only applies if the Examiner has first established a prima facie case that the claimed invention covers a law of nature, natural phenomenon or abstract idea.** See Guidelines IV.C.1. Since the Examiner has never explained how the invention of claim 1 covers a law of nature, natural phenomenon or abstract idea, the Examiner has failed to state a proper rejection.

In a similar fashion, the applicant argues that the terms, “detecting”, “assigning”, “determining” and “transitioning” are all tangible within a computer implemented method (amended claim). Therefore, similar arguments apply to the Examiner’s rejection of claims 8, 9, 17, 18, 19, 20, 27, 28, 36, 37, 38, 39, 46, 47, 55, 56, and 57.

Claims 20 – 38 have been amended to read, “computer-accessible storage medium” to address the Examiner’s rejection due to non-statutory subject matter.

For the reasons given above, removal of the § 101 rejection is requested.

Section 102(b) Rejection:

The Examiner rejected claims 1-5, 9-16, 18-24, 26, 28-35, 37-43, 45, 47-54, and 56-57 under 35 U.S.C. 102(e) as being anticipated by McDowell (Patent Application Publication No. US 2002/0035605 A1) (hereinafter “McDowell”). Applicants respectfully traverse this rejection in light of the following remarks.

Regarding independent claim 1, contrary to the Examiner’s assertion, McDowell does not teach or suggest selectively processing instant messaging operations dependent upon a presence state for a user that is not offline. The Examiner cites McDowell (Table 1, P5) as teaching presence states. The Examiner also cites McDowell, “The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts”, (P4, paragraph 0053, column 2,

last three lines). However, when the entire paragraph (P4, paragraph 0053) is taken into consideration, it's clear McDowell is describing the elimination of inefficient retry attempts to a wireless device that is turned off (i.e. offline). There is nothing to suggest McDowell was referring to presence states other than the device states of ON and OFF. McDowell (P4, Paragraph 0053) reads, "The SMSC 134 does not know if a mobile device is ON or OFF, and therefore must employ a complex, multi-day message delivery and re-display algorithm to ensure that messages are delivered successful. Using the PLIM system 110 according to the present invention, the SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts." Clearly, this is referring the elimination of retry attempts to a device that is turned OFF and is different than Claim 1. McDowell does not describe selectively processing instant messaging operations dependent upon a presence state for a user that is not offline. The presence state recited in Applicant's claim 1 specifically corresponds to a user who is not offline. Thus, the presence state in claim 1 is a presence state for the user, not the on/off state of the user's device. In contrast, the only "selective processing" described in McDowell is based on the device on/off state.

While McDowell does describe user presence states in Table 1 on p. 5, these presence states are not used for the messaging processing described in paragraph [0053]. The only use described in McDowell for the non-device presence states is as passive indicators provided as information-only. The presences states such as "ON-meeting" and "ON-emergency" are not used to selectively process instant messaging operations. In this regard, McDowell's system operates no differently than the conventional instant messaging application described in paragraphs [0004] – [0006] of the Background section of Applicant's specification.

Therefore, for at least the reasons above, Applicants assert that the rejection of independent claims 1 is not supported by the cited art, and removal thereof is respectfully requested. Similar arguments apply in regard to independent claims 20 and 39.

Regarding claim 11, McDowell does not teach performing a stored instant messaging operation in response to detecting a transition to a particular presence states associated with the instant messaging operation, where the particular presence state corresponds to an online user. The operation of McDowell relied on by the Examiner is pertains to a device ON/OFF state, not a user presence state for an online user. Also, McDowell's presence server does not store messages for users that are online. The only time messages are stored by McDowell's presence server is when the user's device is OFF.

Therefore, for at least the reasons above, Applicants assert that the rejection of claim 11 is not supported by the cited art, and removal thereof is respectfully requested. Similar arguments apply in regard to independent claims 30 and 49.

The Examiner also rejected claims 1, 8, 11, 17, 20, 27, 30, 36, 39, 46, 49 and 55 as being anticipated by Aravamudan et al. (U.S. Patent 6,301,609) (hereinafter "Aravamudan"). Applicant respectfully traverses this rejection for at least the following reasons.

The presence states referred to in the applicant's claim 1 are for, **receiving an instant messaging operation directed to a given user, wherein said given user is not offline**. The quotation cited by the Examiner in Aravamudan states, "The IM server also notifies selected buddies to the user of the user's presence **online**." (Emphasis added.) This refers only to online/offline states. However, the selective processing recited in claim 1 is based on a presence state corresponding to a user who is not offline. In other words, the presence state referred to in claim 1 is not an online/offline state, but a further presence state corresponding to the user.

The Examiner asserts that Aravamudan discloses that messages are selectively processed and cites Column 2, paragraph 2 to support the rejection. The citation

discusses priorities assigned by a user to his associates. Example priorities given are high, medium and low. Aravamudan says:

If an associate is assigned a low priority by the user, the associate will never discern whether the user is online or offline, instead the associate will always communicate and interact with the user via the user proxy. If, however, the associate is assigned the highest priority by the user, the associate will discern the user's online status any time he is registered as online. Associates assigned the highest priority by the user, are able to interface with the user directly when the user is online, and interface with the user proxy when the user is offline. (Column 2, paragraph 2.)

This is not **selectively processing said instant messaging operation dependent upon the presence state**. Aravamudan describes a selection process, but it's a different selection process. Aravamudan's selection process is for notifying an associate whether or not the user is **online or offline** based on a priority (i.e. high, medium, low) given to the associate. This is different than the applicant's claim, which is for selectively processing instant messaging operations based on presence state for a given user who is not offline.

Regarding claim 11, the operation of Aravamudan, relied upon by the Examiner, pertains to a device's online/offline state, not a user presence state for an online user. The Aravamudan quote cited by the examiner: "The IM server also notifies selected buddies to the user of the user's presence **online**." (Emphasis added.) This clearly refers only to an online/offline state.

The Examiner goes on to say that Aravamudan also discloses instant messaging operations are stored and then performed. "If the user is located, determined by the user's response to a CSP query, then the user is notified that an important event has been received and the CSP initiates an instant message to elicit the user's instructions for delivery of the content of important event." The applicant again asserts this reference has to do with online/offline status. The implication of the term, "If the user is located" is that the user has been located and/or is online. This is different than the amended claim 11 which states a **presence state corresponds to an online given user**. In other words, the presence state referred to in claim 11 is not an online/offline state, but a further

presence state corresponding to the user. Aravamudan does not teach performing a stored instant messaging operation in response to detecting a transition to a particular presence states associated with the instant messaging operation, where the particular presence state corresponds to an online user.

Regarding independent claims 20, 30 and 39. The applicant's remarks given above for claim 1 regarding Aravamudan also apply to Claims 20, 30 and 39.

Regarding independent claim 49. The applicant's remarks given above for claim 11 regarding Aravamudan also apply to claim 49.

Section 103(a) Rejection:

The Examiner rejected claims 6, 25 and 44 under 35 U.S.C. § 103(a) as being unpatentable over McDowell (US Publication number 2002/0035605, dated March 21, 2002 and further in view of Generous et al, henceforth called Generous (US Publication number US2002/0120697 A1, dated August 29, 2002). Applicant traverses the rejection for at least the following reasons.

The applicant reminds the Examiner that to establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

Regarding claim 6. All the Examiner has done is point out that McDowell and Generous have described the functions of instant messaging, queuing, chatting and the

utilization of buddy lists. The Examiner has not addressed the limitations described in claim 6.

Neither Generous nor McDowell, taken singularly or in combination, teach or suggest notifying users of queuing for a chat operation. In fact, Generous says the user must proactively query for queue status. “The status of each message is tracked so that clients may query for status...” (Paragraph 0035) This is clearly different than a system that queues instant messages dependent upon presence state and notifies the second user of queuing. For this reason, the applicants assert that even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify McDowell as to the advantages of the methods taught by Generous, it is irrelevant to the applicant’s claims because Generous does not teach the limitations found in the applicant’s claims.

The remarks given above for claim 6 also apply to the Examiner’s rejection of claims 25 and 44.

Thus, for at least the reasons presented above, the rejection of claim 6 is unsupported by the cited art and removal thereof is respectfully requested.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: May 1, 2007